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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,781	04/04/2001	Marko Vanska	4208-4007	4818

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EXAMINER	
AVELLINO, JOSEPH E	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/824,781	VANSKA ET AL.	
	Examiner	Art Unit	
	Joseph E. Avellino	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2005*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-36 are presented for examination with claims 1 and 34 independent.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 19, 2005 has been entered.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-26 of Patent 6,678,516 contain each and every limitation of claims 1-36 of the instant application, and as such reject the instant application.

5. Claims 1-43 of application no. 09/860,605 contain each and every limitation of claims 1-36 of the instant application, and as such, reject the instant application.

6. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Court, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

7. Claims 6-9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 5 recites "one of", which all of the service category, a service description, and a requested viewpoint are not needed. As such claims 6-9 are rendered indefinite since they rely on

limitations which are not necessarily required as part of the claim. Correction is required.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-18, 21-25, 31-32, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Doi et al. (US 2001/0014911) (hereinafter Doi).

9. Referring to claim 1, Doi discloses a method of managing user privacy in a network environment (e.g. abstract), comprising:

recognizing one or more service opportunities (the Office takes the term "service opportunities" as any point of presence which can provide access to a user) (i.e. wireless gateway) of a service operator on a user device operated by a user (e.g. abstract);

determining a privacy level (i.e. user identifiable or user anonymous) at which communications is conducted with a service operator (Figures 11-12; p. 6, ¶ 67-73);

conducting the communications with the service operator at the privacy level (Figures 11-12; p. 6, ¶ 67-73);

wherein the recognizing occurs before the determining and the conducting (i.e. a communication setup must be inherently done with the gateway before the communication with the servers).

10. Referring to claims 2 and 3, Doi discloses the user device is a Bluetooth enabled wireless communications device which automatically discovers service opportunities (it is well known in the art that Bluetooth devices automatically search for new service opportunities) (p. 2, ¶ 34).

11. Referring to claim 4, Doi discloses the recognizing comprises anonymously obtaining information relating to the one or more service opportunities (pp. 2-3, ¶ 36).

12. Referring to claim 5, Doi discloses the information relating to the one or more service opportunities comprises a service category (i.e. user identifiable or user anonymous, location dependent or location independent) (Figure 7; p. 5, ¶ 55-62).

13. Referring to claims 6 and 18, Doi discloses allowing the service provider to obtain access to a subset of profile information of the user according to the service category (i.e. user anonymous would not obtain the user identifier from the profile) (pp. 2-3, ¶ 37-39).

14. Referring to claim 7, Doi discloses providing personalized service to the user according to the subset of profile information (i.e. location dependent data is transmitted in the dynamic profile in order to provide the user with personalized service relating to the location of the user) (p. 3, ¶ 43).

15. Referring to claim 8, Doi discloses obtain a subset of profile information of the user according the requested viewpoint (the Office takes the term "viewpoint" as any visual key in order to differentiate this point from any other point, such as traffic directions) (p. 5, ¶ 61).

16. Claim 9 is rejected for similar reasons as stated above.

17. Referring to claim 10, Doi discloses the privacy level includes Anonymous (i.e. if the user ID is never transmitted, then it is considered Anonymous transmission) (pp. 2-3, ¶ 37).

18. Referring to claim 11, Doi discloses the determining a privacy level determines a privacy level based on the nature of the service negotiations with the service operator (i.e. if the user wishes to access location dependent information, it is required to provide the location of the user) (p. 3, ¶ 43).

19. Referring to claim 12, Doi discloses the privacy level is based upon one or more prior transactions with the specific service operator (i.e. if the user has authorized the use of user identification, then the user is unable to proceed back to the anonymous transactions, because they have already authenticated themselves to the system) (Figure 12 and related portions of the disclosure).

20. Referring to claim 13, Doi discloses the determining a privacy level determines a privacy level based on the identity of the service operator (i.e. if the service operator is location dependent, then it must be known where the user is located) (Figure 1; pp. 2-3, ¶ 36-39).

21. Referring to claim 14, Doi discloses the determining a privacy level determines a privacy level based on user-defined parameters (Figure 2, and related portions of the disclosure).

22. Claim 15 is rejected for similar reasons as stated above.

23. Referring to claim 16, Doi discloses obtaining a user identifier (i.e. temporary ID) to conduct pseudonymous communications with the service operator relating to the one or more service opportunities (Figure 3, and related portions of the disclosure).

24. Claim 17 is rejected for similar reasons as stated above.

25. Referring to claim 21, Doi discloses:

determining a profile access level (Figure 2);

transmitting the profile access level to the service operator (Figures 2-3 and related portions of the disclosure);

wherein the service operator obtains a subset of profile information from a profile operator according to the profile access level (Figure 3).

26. Claim 22 is rejected for similar reasons as stated above.

27. Referring to claim 23, Doi discloses determining a profile access determines the profile access level based upon a prior arrangement between the service operator and the user (i.e. determining whether to use a static or dynamic user profile) (Figures 8A-B; p. 5, ¶ 58-61).

28. Referring to claim 24, Doi discloses updating the profile information of the user (Figure 3).

29. Referring to claim 25, Doi discloses updating the profile information based upon user information provided by the service operator (i.e. updating location information in a user profile) (Figure 3).

30. Referring to claim 31, Doi discloses the user device is a mobile wireless device (Figure 6).

31. Referring to claim 32, Doi discloses receiving service from the service operator (e.g. abstract).

32. Claim 34 is rejected for similar reasons as stated above.

33. Referring to claims 35 and 36, Doi discloses conducting the communications comprises the user device controlling the information sent from the device according to the privacy level (the user, through the user device, determines whether the request is for location dependent, or location independent service, and therefore controls what information the service provider receives, either the dynamic and static profile for location dependent service, or only the static profile for location independent service) (p. 5, ¶ 59-64).

Claim Rejections - 35 USC § 103

34. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19, 26-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doi.

35. Referring to claims 19 and 26, Doi discloses the invention substantively as described in the claims above. Doi remains silent upon compensation for obtaining profile information from the user as well as the service provider providing information to the user. However it is well known that third-party advertising servers can pay to obtain mailing lists from companies in order to track advertising for its customers. It is also well known that GPS companies can have subscription services in order to provide users information. By this rationale it would have been obvious to one of ordinary skill in the art to modify the system as described in Doi to include compensation to further enhance commerce and business tactics.

36. Referring to claim 27, Doi discloses the invention substantively as described in claim 24, Doi does not disclose tracking user activity on the user device, however it is well known that servers can use tracking cookies in order to track users throughout their website, and in order for advertisers to determine which advertisements to transmit to the user. By this rationale it would have been obvious to one of ordinary skill in the art to update the dynamic user profile of Doi to include tracking information in order to track users using the system as well as for logging and security systems, which is well known as being under constant attacks from hackers.

37. Referring to claim 28, Doi discloses the invention substantively as described in claim 1. Doi does not specifically disclose the service opportunities recognized by the

user are dynamically changed by the service provider. However, Doi does disclose that the invention can be used in a high speed mobile object such as an automobile, car, etc. (p. 6, ¶ 75), and it is well known that multiple cell towers and GPS satellites are used in order to track a user throughout an area, thereby it would be obvious that the service opportunities (i.e. the wireless gateways would change as the object moves around) would dynamically change in order to compensate for the high rate of speed of the object, thereby allowing the user to stay in communication with the system.

38. Referring to claim 30, Doi discloses the invention substantively as described in claim 1. Doi does not specifically disclose the system communicates across a personal area network. However it is well known that Bluetooth devices, such as described in Doi are compatible with the system, are used in a personal area network to communicate devices close to the user. By this rationale it would have been obvious to one of ordinary skill in the art to allow the user to communicate through a PAN to allow devices close in proximity to communicate while not interfering with other devices further away.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doi in view of Rajchel et al. (USPN 6,496,931) (hereinafter Rajchel).

39. Doi discloses the invention substantively as described in claim 18. Doi does not disclose the profile information is remotely located from the user device. In analogous

art, Rajchel discloses another method of managing user privacy wherein the service provider obtains the profie information (i.e. user information record) from a profile operator remotely located form the user device (Figure 3, 43 and related portions of the disclosure). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Rajchel with Doi to allow a web site operator the ability to track meaningful information regarding the user without compromising the identity of the user as supported by Rajchel (col. 3, lines 18-25).

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doi in view of Carothers et al. (US 2002/0069117) (hereinafter Carothers).

40. Doi discloses the invention substantively as described in claim 32. Doi does not disclose payment for the service obtained by the user is conducted anonymously. In analogous art, Carothers discloses another method of managing user privacy wherein payment for the service obtained by the user is conducted anonymously (p. 1, ¶ 9). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Carothers with Doi in order to allow consumers the ability to barter with one another without needing to be physically present as supported by Carothers (p. 1, ¶ 9).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doi in view of Owen et al. (USPN 6,611,501) (hereinafter Owen).

41. Doi discloses the invention substantively as described in claim 28. Doi does not specifically disclose the service opportunities are dynamically changed by the service provider according to profile information of the user. In analogous art, Owen discloses service opportunities are dynamically changed by the service provider according to profile information of the user (col. 4, lines 35-55). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Owens with Doi in order to provide a mutually beneficial connection between two entities in order for enhanced communication between the computers as supported by Owens (col. 4, lines 59-64).

Response to Arguments

42. Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive.

43. In the remarks, Applicant argues, in substance, that (1) Doi does not disclose recognizing service opportunities of a service operator which occurs before determining a privacy level and conducting the communications at the privacy level.

44. As to point (1) the Office respectfully disagrees. Applicant will appreciate that before any communication between the mobile device and the service providing servers, a session must be set up between the wireless device and the wireless

gateway. Although Doi does not specifically discloses this step, it is an inherent feature to the system, since there is no other way that the mobile device can access the service providing servers without the use of the wireless gateway. Therefore before any data is sent to the servers 21, 22, the mobile device recognizes the wireless gateway and sets up a communication session in order to access the servers. By this rationale, the rejection is maintained.

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

46. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action are now established as admitted prior art of record for the course of the prosecution. See In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
August 30, 2005

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